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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,276	05/12/2000	Neal L. First	96429/9085	6126

7590 11/26/2002

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EXAMINER

WOITACH, JOSEPH T

ART UNIT PAPER NUMBER


1632

DATE MAILED: 11/26/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

File

Advisory Action	Application No.	Applicant(s)	
	09/463,276	First et al.	
	Examiner	Art Unit	
Joseph Weitach	1632		

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Nov 18, 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on Nov 18, 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see NOTE below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached.

3. ☐ Applicant's reply has overcome the following rejection(s):

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 1-15
- Claim(s) withdrawn from consideration: _____
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other:


DEBORAH CROUCH
PRIMARY EXAMINER

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Section 2(a):

The proposed amendments recite new limitations not previously claimed and would require a new search of the art and further consideration. Further, the new limitations raise issues of enablement for the fully scope encompassed by the claims and would require new consideration under 35 U.S.C. 112, first paragraph. In particular the embodiment and breadth to any nuclear donor being capable of providing MET.

Section 5(c):

Applicants' arguments are generally directed to the claim embodiments which have not been entered. With respect to the teaching of Gurdon, it is noted that none of the references cited specifically teach to use a bovine oocyte, however this specific embodiment has not been entered. Similarly, with respect to the 35 U.S.C. 103 rejection, the basis of the rejection as it is directed to the pending claims is maintained for the reasons of record. Examiner would agree that the references fail to specifically discuss the capabilities of the chimeric embryo to accomplish the maternal to embryo transition, and that the art would support that chimeric embryos generated from phylogenetically distant animals are subject to effects in development. However, as noted in the previous advisory action the pending claims encompass an embryo at a one cell stage, and thus the claims are obvious in light of the teachings of the cited references.

With respect to the declaration of Dr. First, comments and arguments presented in the declaration have been fully considered, but not found persuasive because they are directed to

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embodiments which have not been entered. Further, Examiner would agree that differences between bovine and amphibian oocyte and development exist, and is generally supported by the art of record. However, while one type of oocyte may not be absolutely predictive of the properties of another from another species, the artisan was aware of these differences and the manipulation and expected affects of a particular combination would have been considered and tested. Further, given the limited success for the use of amphibian oocyte the expectation of success for species more closely related would have to be specifically considered. However, given the results presented in Gurdon, clearly the closer the genetic relationship of the donor and recipient, the greater the expectation of further development of the chimeric embryo generated.